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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,409	07/18/2003	Angela Temple	14892-004001	4188

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FISH & RICHARDSON P.C.  
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DALLAS, TX 75201

EXAMINER

AUGHENBAUGH, WALTER

ART UNIT PAPER NUMBER

1772

DATE MAILED: 05/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/622,409

Applicant(s)

TEMPLE ET AL.

Examiner

Walter B. Aughenbaugh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 17-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☒ Claim(s) 4 and 9-12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Group I, claims 1-16, in the reply filed on January 18, 2005 is acknowledged.

### ***Claim Objections***

2. Claims 4 and 9-12 are objected to because of the following informalities: in regard to claims 4 and 9, the language is confusing: the phraseology "X is absent" indicates that X is what is absent, not that something else is absent from X; correction/clarification is requested. In regard to claims 10 and 11, it's not clear how a surface would "include" something: does Applicant intend to recite that the sheet having the eye wiping surface includes the solutions of claim 10 and 11? In regard to claim 12, first line, "An" should be replaced with "A". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The structure intended to recited in claim 13 cannot be ascertained. The structure intended to be recited by "a state forming essentially a disc" cannot be ascertained. The recitation "said member is operable to be configured in" immediately prior to the "a state forming essentially a disc" does not require that the member be in "a state forming essentially a disc", so the structure Applicant intends to recite cannot be ascertained.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-7, 9 and 12-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Brown.

In regard to claim 1, Brown teaches a wipe (wipe device, item 10, Fig. 1 and 7) comprising a wiping surface (wiping surface of wiping sheet, item 26, Fig. 3) and a second surface (surface of flexible member, item 24, Fig. 3) opposite the wiping surface and a member (sheath, item 16) on the second surface configured to engage a finger (col. 2, lines 29-38, col. 1, lines 14-15 and Fig. 7). The recitation that the wipe is an “eye wipe” in the first line of the claim and the recitation that the wiping surface is an “eye wiping surface” in the second and third lines of the claim are intended use phrases that have not been given patentable weight, since it has been held that a recitation with respect to the manner in which a claimed article is intended to be employed does not differentiate the claimed article from a prior art article satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQd 1647 (1987). Furthermore, note that no structure is claimed that limits the claimed wipe for use as solely an eye wipe.

In regard to claim 2, Brown teaches that the member (sheath, item 16) is coupled to the second surface to form an elongate cavity (Fig. 2, 7 and 8). In regard to claim 3, Brown teaches that the cavity is substantially tubular having an opening at one end and tapering at the other end (Fig. 2, 7 and 8). In regard to claim 4, the eye wiping surface of Brown does not contain fibrous

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elements because the surface of a sheet cannot contain anything (a surface of a sheet does not have a thickness in which anything can be contained). In regard to claim 5, the eye wiping surface, second surface and member of Brown are composed of a unitary piece of material, because each of these three components are either part of a distinct component of the wipe of Brown (in the case of the eye wiping surface and the second surface) or is a distinct component of the wipe of Brown (in the case of the member). In regard to claim 6, the eye wiping surface of Brown is operable to absorb moisture by virtue of the fact that it is the surface of a wiping sheet (item 26). In further regard to claim 6, note that it has been held that the recitation that an element is “capable of” performing a function (such as “operable to absorb”, equivalently, “capable of absorbing”) is not a positive limitation but only requires the ability to so perform. *In re Hutchinson*, 69 USPQ 138. In regard to claim 7, the eye wiping surface, item 26, of Brown has an oval shape (Fig. 9). In regard to claim 9, the eye wiping surface of Brown is substantially absent of an eye irritant solution.

In regard to claim 12, Brown teaches a wipe (wipe device, item 10, Fig. 1 and 7) comprising a member (sheath, item 16) having a first surface and a second surface (col. 2, lines 29-38). Brown teaches that the member forms a tubular cavity with an open end and a closed end (Fig. 2, 7 and 8). The first surface of the member of Brown is operable to absorb liquid in the instance where the material of the member (sheath, item 16) is cloth, some plastics, leather or synthetic fabric (col. 2, lines 43-46). In further regard to claim 12, note that it has been held that the recitation that an element is “capable of” performing a function (such as “operable to absorb”, equivalently, “capable of absorbing”) is not a positive limitation but only requires the ability to so perform. *In re Hutchinson*, 69 USPQ 138.

In regard to claim 13, the recitation "said member is operable to be configured in a state forming essentially a disc" cannot be treated since no structure of the member is recited: the recitation that the member "is operable to be configured in a state forming essentially a disc" is not a recitation that the member is essentially a disc. In further regard to claim 13, note that it has been held that the recitation that an element is "capable of" performing a function (such as "operable to be configured", equivalently, "capable of being configured") is not a positive limitation but only requires the ability to so perform. *In re Hutchinson*, 69 USPQ 138.

In regard to claim 14, Brown teaches that the open end of the member is substantially circular (Fig. 7 and 8).

In regard to claim 15, Brown teaches that the tubular cavity is sized to receive a finger (col. 2, lines 29-38, col. 1, lines 14-15 and Fig. 7).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 8 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown.

Brown teaches the wipe as discussed above in regard to claims 1 and 12. While Brown fails to explicitly teach that the eye wiping surface of claim 1 or the member of claim 12 has a maximum dimension of less than about two inches, Brown teaches that the wipe is for lenses and similar articles (col. 1, lines 14-16 and col. 2, lines 28-30) and Fig. 7 of Brown depicts the wipe being used on a pair of eyeglasses. Since Brown teaches that the wipe is to be used for wiping the lenses of eyeglasses, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have fabricated the wiping sheet, item 26, of Brown and the sheath, item 16, of Brown such that it is sized such that it has a maximum dimension that is approximately equal to the maximum dimension of the lens that the wipe is intended to be used on, as is shown in Fig. 7 of Brown, in order to make efficient use of the material required for the wiping sheet, item 26, and the sheath, item 16, of Brown, depending on the particular lens which is to be wiped by the wipe of Brown.

9. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown and in further view of Wilkman.

Brown teaches the wipe as discussed above in regard to claim 1.

In regard to claim 10, Brown fails to explicitly teach that the eye wiping surface includes a non-eye irritating solution. Wilkman, however, discloses wipes that are impregnated with a formulary selected for a particular purpose, such as a cleaning fluid, a baby wipe or an eye makeup remover (col. 1, lines 10-13 and 27-33 and col. 4, lines 9-11 and 19-22). Since Brown teaches a wipe for wiping eyeglass lenses, and since Wilkman discloses the use of wipes as a baby wipe and as an eye makeup remover, both of which are necessarily non-eye irritating, and

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both of which contain cleaning solutions, one of ordinary skill in the art would have recognized to have included a non-eye irritating cleaning solution in the wipe of Brown such as a baby wipe solution or an eye makeup remover solution as taught by Wilkman, in order to more effectively clean the lenses via use of the cleaning solution in the wipe while also preventing eye irritation via use of a non-eye irritating cleaning solution.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a non-eye irritating cleaning solution in the wipe of Brown such as a baby wipe solution or an eye makeup remover solution as taught by Wilkman, in order to more effectively clean the lenses via use of the cleaning solution in the wipe while also preventing eye irritation via use of a non-eye irritating cleaning solution.

In regard to claim 11, Brown fails to explicitly teach that the eye wiping surface includes a solution operable to remove makeup. Wilkman, however, discloses wipes that are impregnated with a formulary selected for a particular purpose, such as an eye makeup remover for removing eye makeup (col. 1, lines 10-13 and 27-33 and col. 4, lines 15-22). Since Brown teaches a wipe for wiping eyeglass lenses, one of ordinary skill in the art would have recognized to have included an eye makeup remover in the wipe of Brown in order to more effectively remove eye makeup from the lenses via use of the eye makeup remover in the wipe of Brown as taught by Wilkman.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included an eye makeup remover in the wipe of Brown in order to more effectively remove eye makeup from the lenses via use of the eye makeup remover in the wipe of Brown as taught by Wilkman.



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*Conclusion*

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: US 5,694,659 to Merrion.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B. Aughenbaugh whose telephone number is 571-272-1488. The examiner can normally be reached on Monday-Thursday from 9:00am to 6:00pm and on alternate Fridays from 9:00am to 5:00pm.

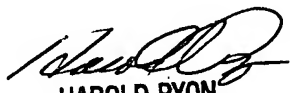
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Walter B. Aughenbaugh

04/29/05

WBA

  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772

4/29/05